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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 083022-0278802												
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/005,415	Filed  11/07/2001												
	First Named Inventor  Mitchell D. Eggers													
	Art Unit  2142	Examiner  HARRELL, Robert B.												
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature Anthony G. Smyth</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 55636 Registration number _____</td><td>Typed or printed name 858.509.4007</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>Telephone number November 28, 2006</td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant/inventor.		<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature Anthony G. Smyth	<input checked="" type="checkbox"/> attorney or agent of record. 55636 Registration number _____	Typed or printed name 858.509.4007	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number November 28, 2006		Date	<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 083022-0278802

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: EGGERS  
Application No.: 10/005,415

Confirmation Number: 9374  
Group Art Unit: 2142

Filed: November 7, 2001

Examiner: HARRELL, Robert B.

Title: AUTOMATED BIOLOGICAL SAMPLE ARCHIVE FOR STORAGE, RETRIEVAL  
AND ANALYSIS OF LARGE NUMBERS OF SAMPLES FOR REMOTE CLIENTS

**Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**Pre-Appeal Brief Request for Review**

This request is submitted concurrently with a Notice of Appeal in the above-listed Application. The Notice of Appeal is timely filed in response to the Office Action mailed on August 28th, 2006.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

### **REMARKS**

In the Office Action of August 28, 2006 (“the FOA”), claims 1-60 were finally rejected under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent Publication No. 2004/0098204 by Milosavljevic (“Milosavljevic”). Applicant traverses these rejections because Milosavljevic does not teach each and every element of the claims, arranged as they are in the claims. Additionally, the §103 rejections of the claims are also improper for at least the reason that Brignac does not cure the deficiencies of Milosavljevic. Furthermore, certain double patenting rejections have been made in the case; appropriate terminal disclaimers can be provided when the Examiner acknowledges the allowability of the claims.

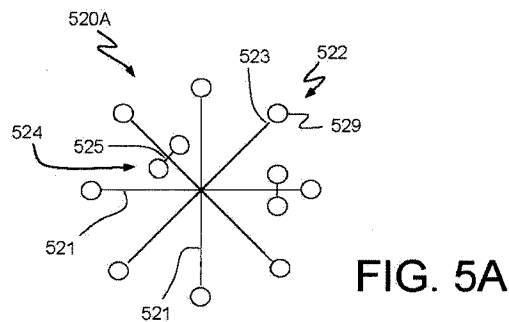
Regarding the §102 rejections, Milosavljevic does not teach discrete sample nodes, each sample node removably attached at a respective attachment point. A cited prior art reference anticipates a claimed invention under 35 U.S.C. §102 only if every element of the claimed invention is identically shown in the single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990). Each and every limitation of the claimed invention is significant and must be found in the single cited prior art reference. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985). As set forth below, Milosavljevic does not disclose each and every element of the claims arranged as they are in the claims.

Regarding the required discrete sample node, the FOA proposes that test sites taught in Milosavljevic are discrete because probes in each test site “differ.” FOA at page 4, section 13(a), lines 4-6. This proposal does not admit a §102 rejection of the present claims because the word “differ” is not equivalent to the word “discrete.” For example, salt and sand exhibit different physical properties and chemical behaviors. Therefore, a mixture of salt and sand can be said to contain at least two components that differ but the mixture cannot be said to be include discrete salt and sand components. As recited in the claims and as commonly used, the term “discrete” means: “constituting a separate entity, individually distinct” or “consisting of distinct or unconnected elements.” Merriam-Webster Online Dictionary at <http://www.m-w.com/dictionary/discrete>. It is apparent that the Examiner applies a definition to the word “discrete” that is not supported by Milosavljevic and is inconsistent with the definitions of

discrete sample node provided in the Application and with common usage of the word. Therefore, the claims are improperly rejected.

Nevertheless, the Examiner attempts to support his proposed redefinition of “discrete” by asserting that “the sample must be discrete in Milosavljevic to prevent for [sic] cross contamination of the samples...” FOA at page 4, section 13(a), lines 6-11, citing Fig. 5A and paragraphs [0094] and [0118] *et seq.* in Milosavljevic. However, nothing in Milosavljevic substantiates the Examiner’s assertion. Milosavljevic is completely silent regarding cross-contamination and the word “discrete” cannot be found anywhere in Milosavljevic. Cited paragraph [0094] of Milosavljevic discusses the investigation and interrogation of samples fabricated using systems and methods described in U.S. Patent No. 6,083,763 to Balch (“Balch”). Applicant submits that nothing in Balch justifies the Examiner’s assertion. Balch is concerned with cross-contamination in *capillaries* in an ink-jet system that is used to print test sites on a common substrate. Nothing in Balch teaches or suggests the use of discrete sample nodes as a method to prevent cross-contamination. Furthermore, paragraph [0118] can be found in a section of Milosavljevic entitled “Description of System Software.” This section describes a computer system for automating testing of samples received from customers. Nothing in the Milosavljevic’s description of system software teaches or suggests a discrete sample node. Therefore, the Examiner erred by basing the §102 rejections on an unsupportable assertion that Milosavljevic samples must be discrete to prevent cross contamination. Applicant further submits that such baseless assertion would be improper even in a §103 rejection.

Turning now to the required attachment point: nowhere in Milosavljevic can a teaching or suggestion of an attachment point be found. Milosavljevic is completely silent regarding points of attachment associated with sample nodes. The Examiner has provided citations to numerous paragraphs and figures, none of which teach or suggest the attachment points required in the claims. Nor does the Examiner provide any teaching or suggestion of an arrangement in which discrete sample nodes 529 are removably attached to sample structures 522, 524 at attachment points 523, 525 respectively. See Specification at page 32, lines 1-18 and Fig. 5A (reproduced below).



Milosavljevic merely teaches the use of a pattern of test sites created on a common substrate and nowhere discusses removable attachment of such test sites or any attachment point or means. In the incorporated Balch reference, Milosavljevic teaches that the 4x4 matrix microarray is printed on a glass substrate. Balch, col. 30, lines 41-54. The Examiner does not provide any citation that shows where individual test sites are removably attached at attachment points or even where test sites printed on glass are taught as being removable. Nothing in Balch teaches or suggests a differentiable point on a glass surface that could even serve as an attachment point. Nor do any of the examples provided in Balch teach test sites amenable to removable attachment at an attachment point. Furthermore, Milosavljevic does not teach an inventive step of providing attachment points at which Balch's test sites/microarray elements could be removably attached. Therefore, Milosavljevic does not teach attachment points and cannot possibly teach discrete sample nodes removably attached at such attachment points.

Finally, the Examiner speculates that the ability to ship and test an array of samples somehow anticipates the required attachment points at which discrete sample nodes are removably attached. Applicant respectfully submits that the lack of support in Milosavljevic for the Examiner's interpretation of the teachings of Milosavljevic and the intrinsic incoherency of the reasoning provided in support of such speculative interpretation do not warrant further argument beyond that provided above. In short, the cited art does not teach discrete sample nodes, each removably attached at respective attachment points.

Therefore, and for at least these reasons, the cited art does not teach every element of the claims as arranged in the claims and the §102 rejections should be withdrawn.

CONCLUSION

For at least the reasons provided above, Milosavljevic cannot be said to disclose each and every element of claims 1-60, arranged as they are in claims 1-60 and the §102 rejections of claims 1-60 are improper. The Brignac patent application does not teach discrete sample nodes removably attached at respective attachment points either and, consequently, the §103 rejections are also improper because the combination of Milosavljevic and Brignac does not teach every element of the claims. Therefore, the rejections of all §102 and §103 claims in the Application should be withdrawn such that appropriate terminal disclaimers may be filed in order to a permit the Examiner to issue a Notice of Allowance.

Respectfully submitted,

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